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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,228	11/17/2003	Teresa Hickok	19783-025001 / 24/1197US	5020
20985	7590	04/20/2007	EXAMINER	
FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			WILSON, JOHN J	
			ART UNIT	PAPER NUMBER
			3732	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/715,228

Applicant(s)

HICKOK ET AL.

Examiner

John J. Wilson

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 21, lines 14 and 15, "the thickness", lacks antecedent basis and is unclear because there are several orientations that "the thickness" could be considered from, and further, the specification does not define the term. For purposes of this rejection it is assumed that – a thickness – was intended.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hugo (6022217) in view of Banko (3930173). Hugo shows an oscillating tool having a shank including thicker proximal and distal portions as shown, Figs. 2-4, a hollow internal volume at the proximal portion as shown and a guide channel 27. To call the reduced thickness intermediate portion a void is merely a matter of terminology to one of ordinary skill in the art. Hugo does not show an ultrasonic tool or an open guide

channel. Banko teaches an ultrasonic tool and an open guide as shown at the intermediate portion of 12. It would be obvious to one of ordinary skill in the art to modify Hugo to include vibrating the tool ultrasonically in order to obtain the desired cutting ability and to use an open channel in order to distribute fluid as shown by Banko. As to claims 25 and 26, the specific shape of the guide channel is an obvious matter of choice in the shape of a known element to the skilled artisan. As to claim 27, the method of producing the groove is an obvious matter of choice in processing steps to one of ordinary skill in the art.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hugo (6022217) in view of Banko (3930173) as applied to claim 21 above, and further in view of Bussiere (D261932). The above combination does not show a void having a planar base. Bussiere shows a void having a planar base. It would be obvious to one of ordinary skill in the art to modify the above combination to include a void shaped as shown by Bussiere in order to make use of art known shapes of known structures.

Claims 28, 30 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hugo (6022217) in view of Banko (3930173) as applied to claim 21 above, and further in view of Jacoby (5230621). The above combination does not show using a rasp or file. Jacoby teaches using a file for the working end, column 2, line 47. It would be obvious to one of ordinary skill in the art to modify the above combination to include a file as shown by Jacoby in order to make use of the desired tool to complete

the desired procedure. The specific type of file used is an obvious matter of choice in known files to the skilled artisan. As to claim 32, Jacoby teaches a file, using cross grooves on a file is well known and would have been obvious to one of ordinary skill in the art. As to claim 33, the above combination does not show using a hollow tube. Jacoby shows an embodiment in Fig. 3b that teaches a tube 53, 55 having an opening 57. The tube passes through the tip as show. Jacoby also shows an embodiment, Figs. 7, 7b, where the element 24 is located in a groove, Fig. 7b. It would be obvious to one of ordinary skill in the art to modify the above combination to include a tube as shown by Jacoby in order to deliver the desired accessory to the work site. As to claim 34, to use a bushing is an obvious matter of choice in known ways of mounting a tube to the skilled artisan. As to claim 35, the specific range of length that the tube extends is an obvious matter of choice in size and positioning of the known elements to one of ordinary skill in the art.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hugo (6022217) in view of Banko (3930173) as applied to claim 21 above, and further in view of Hahn (6139320). The above combination does not show a ball at the working end. Hahn shows using a ball working end 154, Fig. 13. It would be obvious to one of ordinary skill in the art to modify the above combination to include a ball working end as shown by Hahn in order to use the tool needed to perform the desired procedure.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hugo (6022217) in view of Banko (3930173) as applied to claim 21 above, and further in view of Kleesattel et al (3058218). The above combination does not show a drill at the working end. Kleesattel shows using a drill, Fig. 7, at the working end. It would be obvious to one of ordinary skill in the art to modify the above combination to include a drill working end as shown by Kleesattel in order to use the tool needed to perform the desired procedure.

Specification

The specification and/or drawings are objected to because element 303, axis or central axis, as described in the specification is not shown in the drawing. The only 303 in the drawings is shown in Fig. 11A, and it does not appear to be directed to an axis.

Response to Arguments

Applicant's arguments filed March 19, 2007 have been fully considered but they are not persuasive. Applicant's remarks are held to be moot in view of the newly applied reference and rejections above.

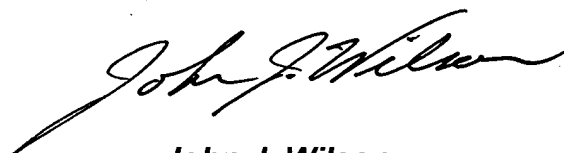
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722). The examiner can normally be reached on Monday through Thursday.

Art Unit: 3732

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez, can be reached at 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Wilson
Primary Examiner
Art Unit 3732

jjw
April 16, 2007